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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,394	01/30/2001	Peter Stangel	MG-001-US	1200

7590 01/20/2006

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EXAMINER

BUI, KIM T

ART UNIT PAPER NUMBER

3626

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/772,394	Applicant(s) STANGEL, PETER	
	Examiner Kim T. Bui	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 08/31/2005. Claims 1-15, 17-29 are pending. Claims 1-15, 17-19 are amended. Claims 20-29 are added. Claim 16 is cancelled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7, 9-14, 18-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) As per claim 1, it is unclear what are the structures of the system, the preamble of the claim recites the computer implemented system, consisting of one or more computers, the internet network, and a local area network, However, the body of the claim recite no structure, only the "modules".

In addition, there is/are no interconnection between the "modules" with the internet, the network and/or the one or more computers.

On line 15, it is unclear how the "server computer" is interconnected to the internet, the local network and/or one or more computers.

(B) As per claim 9, "said finding" on line 9 lacks clear antecedent basis. It is unclear if "said finding" refers to " at least one finding" on line 6 or "one of the entered findings" on line 7.

(C) As per claim 12, it is unclear what is /are the structure(s) of the claim. There is no structural limitation and practical application resulted by the "the set of lists" recited in the body of the claim.

(D) As per claims 13, 14, 23-28 it is unclear what are the structures of the claims. In addition, it is unclear how these claims further limit the independent claim 12.

(E) As per claim 18, the preamble recite single screen submission of patient clinical data in a patient care review system. However, there is/are no step the body of the claim to support the reviewing and/or single submission of patient clinical data.

In addition, "system/group" on lines 6, 7, 10 is unclear. It is unclear it refers to system group interface, system and group interface, or system or group interface.

(F) As per claim 19, "user of in" on line 2 should read "user in".

(G) As per claim 20, "download of patient clinical encounters" on lines 1-2 is not descriptive. The examiner interprets this as "download data of patient clinical encounters"

(H) As per claim 29, the claim recite no structure, it is unclear what are the interconnected structural elements that made up the recited system.

(I) Dependents claims 2-7, 10-11, 21-28 incorporate the deficiencies of the claim they dependent on and are therefore rejected.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-8,12-14,18 and 23-28 are rejected under 35USC 101 because the

claimed invention is directed to non-statutory subject matter.

(A) As per the apparatus claims 1-7, 12-14, 23- 28, the claims recite a collection of modules software modules and an interactive set of lists, which appears to be a collection of non-functional descriptive material. The claims are therefore considered non-statutory because they are not capable of causing a functional change in a computer. As drafted, the claim fails to define any structural and functional interrelationships between the software modules and other elements of a computer that permit the computer program's function to be realized. (See MPEP § 2106)

(B) Method claims 8, 18, recite the steps for providing and receiving that yield no tangible results. The language "is adapted to be examined so as to facilitate" in the providing step of claim 8 does not positively recite a tangible result. For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. Under this analysis, the present language of claims 8 and 18 fail to recite a tangible result, and therefore, considered non-statutory. (See MPEP § 2106).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 8 and 15, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Provost et al. (6341265)

(A) As per claim 8, the amendment to the claim does not affect the scope of the claim as originally filed and/or in the manner the claim was interpreted by the Examiner. As such, claim 8 is rejected under the same rationale given in the previous Office Action, dated 03/01/2005, and incorporated herein.

(B) As per claim 15, The claim has been amended to recite "patient clinical"; "a user"; "connected by the internet to a server computer providing"; "at the user site"; "input from"; "in a clinical chart format"; "inputs from"; "diagnosis associated clinical criteria"; " configuring inputs from the form to apply a second set of rules for clinical patient encounter", " patient clinical "and "the first ". Provost teaches user computer connected by the Internet server site in Fig. 1. The Examiner interpret the tubular form for recording data for a claim form in a clinical environment shown disclosed by Provost as clinical chart format; the entry of diagnosis, treatment, nature of illness, dates of services, place, time, service provider etc as entry of patient clinical data (Provost, Figs 2, 3); the forming (i.e. configuring) inputs from the form to apply one set of rules (rules

for determining whether the types of diagnosis and treatment that are covered /approved by the insurance or HMO), for determining whether the diagnosis/treating corresponding to services that are approved as a form of apply a first set of rules for authorizing diagnosis associated clinical criteria (Provost, col. 10, lines 1-24) , and the forming (i.e., configuring) inputs from the form to apply another set of rules for a clinical patient encounter (i.e., beneficiary, validity and accuracy) as applying a second set of rules for clinical patient encounter (Provost, Figs 2,3, col. 6, lines 47-62, col. 8, lines 21-32, col. 8, lines 59-67, col. 4, lines 7-21).

As per the steps for receiving patient clinical data (i.e. diagnosis, treatment, nature of illness, dates of services, place, time, service provider etc..) from health care provider interacting with the client or user site, and for processing the received data automatically with the two sets of rules. Provost discloses these steps in Figs 1-3, col. 9, lines 15-35, col. 10, lines 1-24, and as discussed in the prior Office Action, dated 03/01/2005, and incorporated herein.

(C) As per claim 29, Provost discloses a system the prompt for clinically relevant inputs used to generate an electronic record of a patient clinical encounter in real time for review by health care reviewing organization and that automatically evaluates clinical data for individual criteria and for the patient encounter. Provost, the abstract, col. 7, lines 60-65, col. 8, lines 59 to col.9, line 35. The examiner interprets the electronic claim form as electronic record of a clinical encounter of the patient, and the Internet connection as real time operation.

8. Claims 18, 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Jacobs (6049794)

(A) As per claim 18, Jacobs discloses a computer implemented system having user interface for submitting and reviewing clinical data comprising:

a. providing an element selection interface facilitating the selection of an element .

Jacobs, Fig 20, element 80, col.9, lines 35-58.

b. proving a system/group selection interface facilitating the selecting a system group of the selected element. Jacobs, Fig. 20, category buttons 194, 196,198,208, col. 9, lines 35-38.

c. providing a parameter selection interface facilitating the selection of a parameter of the selected group. Jacobs, Fig. 20, menu text screen 210 corresponding to selected group IRM, col. 9, lines 35-38.

(B) As per claim 19, has been amended to recite "appropriateness of a patient clinical encounter", "in an electronic clinical charting system", "diagnosis-relevant clinical", "based", "each selected criterion", "each criterion",

Jacobs teaches methods for providing an indication of appropriateness of a patient clinical encounter to a user in the electronic charting system that facilitates the submission of diagnosis relevant clinical data. Jacobs, col. 8, lines 2-4, col. 2, lines 23-25, 43-45, 59-64, Fig. 4., the diagnosis based criteria is disclosed in Jacobs col. 5, lines 13-18, the indication of authorization level (i.e., criteria met, criteria not met) is displayed within each selected criterion. Jacobs, Figs 17, 21.

The remainders of claim 19 is rejected for the same reasons given in the prior Office Action, dated 03/01/2005.

9. Claims 12-14, 23-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Roberge et al. (6381611).

(A) As per claim 12, Roberge disclose an interface for entering data for evaluation of clinical encounter, comprising:

a. an interactively set of lists (i.e. hierarchically organized database for navigation display shown in Figs 1, 7, 8 of Roberge), each display in its own pop up button list (i.e. selection of each button in Figs 7, 8 caused the display of its own pop up lists, "cardiac" is displayed in its own pop up list (symptoms, test, labs, medications), "test" is displayed with its own pop up list (cath, echo, stress), and each list in Fig. 1 has each own nodes and branch (i.e., its own domain). Roberge, Figs 1,7,8, lines, col. 6, lines 10-30.

(B) As per claim 13, Roberge teaches the display of a parameter (i.e., Left ventricle) and associated finding (i.e. 56 cm) on a single line. Roberge, Fig. 15, element 159, col. 8, lines 43-45.

(C) As per claim 14, Roberge teaches the entry of more than one findings (size 50 cm, thickness 10mm) for one parameter (LV, left ventricle). Roberge, Fig. 6b, col. 5, lines 63-66.

(D) As per claim 23, Roberge teaches at least four button lists are display and include at least on element list (i.e., Cardiac), a system/group list (i.e., Symptoms, Tests, Labs, Medications), a parameter list (i.e., Left Ventricle, Right Ventricle,

Cardiomyopathy), a findings list (i.e. Size, Thickness, Function). Roberge, Fig.1, col. 6, lines 10-17.

(E) As per claim 24, Roberge teaches a selection in one list populates a list in the next pop up button list (e.g., selection of LV, left ventricle in a parameter list populate a finding list (size, thickness, function) in the next pop up button list. Roberge, Figs 1,13, col. 7, lines 59-65.

(F) As per claim 25, Roberge teaches a selection in an element pop up list (Cardiac) populates a system/group pop up list (list (i.e., Symptoms, Tests, Labs, Medications), a selection in system/group populates a parameter pop up list (i.e., Left Ventricle, Right Ventricle, Cardiomyopathy), and a selection in a finding list directs the user to enter a numerical value finding along with the selected parameter into chart note data fielding a clinically formatted on screen display. Roberge, Fig 1 and Fig. 15, col. 6, lines 18- 42 col. 7, lines 50-57, col. 8, lines 39-45.

(G) As per claim 26, Roberge teaches the selection in a criteria pop up list set the lists (element, group/system, parameter, findings, etc.,) to enable the user to select the findings. Roberge, col. 3, line 64 to col. 4, line 15, Figs. 1,9.

(H) As per claim 27, Roberge teaches the two steps for selecting the finding, and for entering of numerical value. Roberge, col. 7, lines 50-53.

(I) As per claim 28, Roberge teaches the selection in additional pop up list sets element, system/group, parameter and finding lists to enable the selection of the finding. Roberge, col. 9, line 25 to col. 10, line 11.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 9-11, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provost et al. (6341265).

(A) As per claim 9, the claim has been amended to recite "diagnosis based criteria", "a database residing on a server computer", "findings that meets criteria" and a step for "generating a clinical record based on said finding"

Provost teaches the database 20 and the server computer 14 and the step for entering the finding that meets criteria on col. 9, lines 38-43, and col. 9, line 65 to col. 10, line 16. Provost teaches the entering of information into a claim payment form (i.e. clinical record), the entered data is transmitted to the server and its database. Provost, col. 9, line 66 to col. 10, line 9. It is readily apparent that the transmitted data is stored/entered into database of server for processing of the clinical record (i.e. claim payment form).

Provost teaches the step for creating the clinical record (i.e., claim form) based on the entered data including finding (i.e. nature of illness). It is the examiner interpretation that "creating the claim form based on inputted data having diagnosis, treatment codes, nature of illness" is a form of "generating of the clinical record based on the finding".

The remainders of claim 9 are rejected for the same reasons given in the previous Office Action, dated 03/01/05, and incorporated herein.

(B) The amendments of claims 10,11 do not change the scope of the claims, nor the way the Examiner interpreted the claims. Claims 10,11 are rejected for the same reasons given in the previous Office Action, dated 03/01/05, and incorporated herein.

(C) As per claim 17, Provost teaches that the authorization level (i.e. beneficiary, validity, accuracy, diagnosis/treatment and payment) and that if authorization level fails (user is not beneficiary, information is not valid/accurate), the system inform the user the results so that the status can be learned before proceeding. Provost et al, col. 8, line 64 to col. 9 line 6. Provost fails to expressly recite that the indication of an authorization level (i.e. beneficiary, validity, accuracy) is indicated to the user before the submission of the form. However, Provost teaches that those skilled in the art will understand that the practice of his invention can be implemented with many types of computer system configuration, instructions and program modules can be stored at both the local and remote locations. Provost, col. 6, lines 47-60. As such, it is within the level of an ordinary skill in the art to allow the user to make a correction regarding beneficiary, validity or accuracy before submission of the form to the user site. For practical purposes, it would have been obvious to one having ordinary skill in the art to indicate authorization level (i.e., beneficiary, validity, accuracy) prior to submission with the motivation of saving processing time at both the user and server sites. Provost, col. 11, lines 50-65.

12. Claims 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobs (6049794)

(A) As per claim 20, Jacobs teaches the clinical data in clinical format for reviewing by different users. Jacobs, col. 2, lines 28-55. It is unclear if Jacobs teaches the download of data of the patient clinical encounters. However, Jacobs teaches on col. 10, lines 44-68 the linkages to other systems and the import of data capabilities.

It would have been obvious to one having ordinary skill in the art at the time of the invention to include linkages and importing (i.e., downloading) of clinical data with the motivation of expanding the applicability of the system by incorporating information from external source. Jacobs, col. 10, lines 48-50.

(B) As per claim 21, Jacobs teaches the plurality of users including physician and physician aids (i.e. nurse). Jacobs, Fig. 3, col. 5, lines 33-38.

13. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provost et al. (6341265) in view of Jacobs et al (6049749).

(A) Claim 1 has been amended to recite "one or more computers connected by one of an internet or local area network", "electronic", "patient clinical encounter", "for review by", "reviewing", "module", "identified" and "to a server computer".

Provosts teaches one or more computers connected by the internet or local network, a server computer, the determination of an authorization level for beneficiary, validity, accuracy, and diagnosis/treatment, and the step for generating of electronic clinical record (i.e., electronic claim form) of a patient clinical encounter for reviewing by

health care organization in Figs 1-3, col. 3, lines 25-63, col. 7, lines 1-20, col. 9, lines 15-58, col. 9, line 65 to col. 10, line 16, col. 8, line 59 to col. 9, line 6, col. 10, line 60-67.

As per "the determination of authorization level before the submission of the record to a server computer" recitation. Provost teaches the task of verification is assigned to the server, not at the client terminal. However, Provost teaches those skilled in the art will understand that the practice of his invention can be implemented with many types of computer system configuration. As such, it is within the level of an ordinary skill in the art to process the verification at the local terminal before submission of the record to a server with the motivation of providing flexibility in the designing of the system configuration to reduce the processing time at the server node. Provost, col. 6, lines 47-60.

The remainders of claim 1 are rejected for the same reasons given in the prior Office Action, dated 03/01/2005.

(B) As per claim 5, the claim has been amended to recite "on the server computer". Provost teaches that rules for verifications are stored in databases 18, 20 of the server computer. Provost, Fig.1.

The remainders of claim 5 are rejected for the same reasons given in the prior Office Action, dated 03/01/2005, and incorporated herein.

(C) The amendment to claims 2-4, 6 do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claims were interpreted. Claims 2-6 are rejected under the same rationale given in the prior Office Action, dated 03/01/05, and incorporated herein.

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Provost et al. (6341265) in view of Jacobs et al (6049749) as applied to claim 1 above and further in view of Roberge et al. (6381611).

(A) As per claim 7, the claim has been amended to recite "the system of claim 1, when two or more computers are used"; "module on the client computer for generating screens to enable the submission of data to be submitted to the server computer", "a user interface to facilitate the submission of clinical data to the server system, the user interface coupled with a form database on the server computer that is used in generating user screens on the client computer by which data is entered"; "server computer associated with the user interface"; "navigation moduleautomatically modifying fields of a respective screen in response to a user's entering data there in"; "server computer database, associated with the navigation module for storing"; "module" and "said determination performed prior to submission of the clinical record to the server"; " server computer; associated with the verification module foron the client computer"; and "in real time whether each data entry meets one or more criteria for determining for authorization"" .

Provost teaches the system when two or more computers are used. See Provost ,Fig. 1;

Provost teaches the user interface module on the user (i.e. client computer) to enable the submission of data to the server, the interface is coupled to a form storage device located at local or server data base used in generating the screens on the client

computer by which data is entered. Provost, Figs 2,3, col. 9, lines 19-43, col. 8, lines 22-32.

As per "the determination performed prior to submission of the clinical record to the server" and the evaluation on the real timer basis. Provosts teaches the task of verification is assigned to the server. However, Provost teaches those skilled in the art will understand that the practice of his invention can be implemented with many types of computer system configuration, instructions and program modules can stored at both local and remote locations. Provost, col. 6, lines 47-60. As such, it is within the level of an ordinary skill in the art to allocate processing capabilities between the client and the server terminals. It would have been obvious to an artisan to process the verification at the local terminal before submission of the record to a server with the motivation of providing flexibility in the designing of the system configuration to reduce the processing time at the server node. Provost, col. 6, lines 47-60.

Provost teaches the Internet application, examiner interprets this as real time operation. See Provost, col. 11, lines 50-65.

As per the interactive navigation module operable to automatically modifying fields) with updated display as data is entered. Provost fails to expressly recite this navigation module. This, however, is well known as evidenced by Roberge et al. Roberge teaches a navigation module in which size field 134 in Fig 13 in response to the entered data corresponding to the size elements 121, 122 in Figs 12 a, 12b. See Roberge et al. col.2, lines 60-65, col. 6, lines 10-55, Figs 12a, b and Fig. 13, element 134, col. 7, lines 54-59.

It would have been obvious to one having ordinary skill in the art to adapt navigation module into Provost with the motivation of facilitating the entry of data. Roberge, col. 2, lines 40-45.

The remainders of claim 7 are rejected for the same reasons given in the prior Office Action, dated 03/01/2005.

Response to Arguments

15. Applicant's argument filed on 08/31/2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below:

(A) On pages 13-18 of the Remarks, with respect to the rejections of claims 8-11, 15-17, applicant argues that Provost entered data manually and there is no selection from the lists of values. In response, it is respectfully submitted that the Applicant fails to consider the scope and breadth of his claimed invention, and argued features that are not recited in the claims.

The claims as presented do not recite selection automatically or from list of values. Provost clearly teaches the selection module for selection of diagnosis codes on col. 9, lines 15-58. These codes are predefined and selected, the provider selects and enters the codes in to appropriate fields. It is respectfully submitted that claim 1 broadly recites "a selection interface module" adapted to facilitate the selection of at least a diagnosis. This is disclosed by the selection interface in Figs 2,3 and the selection of diagnosis on col. 9, lines 15-58 of Provost.

Applicant argues that the real time and instantaneously limitations. In response, claims 8-11, 15-17 do not recite real time or instantaneously.

In addition, the examiner interprets the Internet applicability disclosed in Provost as real time operation.

Applicant further argues that Provost teaches claim payment, not clinical record. It is respectfully submitted that the language of "clinical record" or "clinical record format" is broad and is met by the "claim payment format" of Provost. The claim payment format is a record submitted by the user for payment in a clinical environment, and is therefore, represent a form of clinical record. In addition, Applicant does not recite the details or structure of the clinical record in the claims. The limitations argued by the applicant regarding the clinical record are not in the claims.

Applicant also argues that in Provost, the authorization is not for diagnosis. Examiner disagrees, Provost teaches the approval of payment, but the approval is based on the determination whether or not the diagnosis code and treatment codes are corresponding to the accepted procedures/services. As such, Provost teach a form of authorizing diagnosis for the approving of payment.

In general, Applicant fails to consider the scope and the breadth of his claimed invention and argues features that are not recited in the claims. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant argues and relies through out pages 13-19 (i.e., "a clinical record includes the documentation of a patient's symptoms, examination, the ordering, and the results of lab tests, the ordering and results of lab tests diagnosis, treatment and medications"; "the data entry displays a clinical finding in a clinical chart format used by clinicians in the practice of medicine";

"selection from a list of values"; "Applicant's invention processes authorization of care on the client system in real time as data is being entered"; "entering one or more diagnosis by selection from a pop up lists populated by selecting an ICD 9 group consisting of range of ICD9 codes, e.g. ICD9 codes 486 is selected from a list of codes populated by selecting the ICD9Coded group 460-519"; "specific patient finding made by the health care provider, e.g., which are required to support the diagnosis code, e.g. Wheezing heard on auscultation of (listening to) the chest is displayed, e.g. Chest: Auscultation: wheezing"; "multiple findings of ronchi (coarse sounds) is added to the findings of wheezing for chest auscultation, e.g., Chest: Auscultation: wheezing; ronchi"; "specific request for specific information"; "specific additional information relevant to a diagnosis and encounter to support the diagnosis and encounter"; "both first set and second set of rules operative real time on the client site"; "Applicant's invention informs a user of authorization status real time and instantaneously"; "verification module is downloaded with the forms to the user system and is coupled with the form on the user system"; "Feedback is given as on screen presentation of the entered data in a clinically formatted chart note display", etc..) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to the sets of rules, Applicant argues that the first set of rules apply to individual diagnosis derived criteria, and a second set of rules apply to the patient care encounters as a function of meeting criteria of one or more diagnosis for the

patient clinical encounter. It is respectfully submitted that Applicant argues features that are not in the claims. In addition, Provosts clearly teaches at least two sets of rules for determining criteria status from the entered data of identified fields, and the diagnosis authorization as set forth in the prior Office Action dated 03/01/2005, and incorporate herein.

(B) On pages 18-19 of the Remarks, with respect to the rejections of claims 1-6. Applicant repeats the arguments that a selection interface module adapted to facilitate to selection of at least one diagnosis" is not disclosed by Provost; "a claim is not a clinical record"; and "diagnosis is not authorized". Applicant is directed to the above "section A" in response to these arguments.

Applicant further argues the downloading of verification module and the feedback. It is respectfully submitted that these limitations are not recited in the claims.

Furthermore, Applicant argues that Jacobs determines verification on single indication, which is usually a clinical finding. In contrast, Applicant system evaluates the appropriateness of patient clinical encounter by one or more criteria dependent diagnosis and gives feedback for each criterion. In response, it is respectfully submitted that the features argued by the applicant are not in the claims and that Jacobs clearly teaches the medical decision making for determining appropriate level of care/diagnosis as discussed in the previous Office Action, dated 03/01/05, and incorporated herein. The verification module is disclosed Provost as set forth in the previous Office Action. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are

based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(C) On pages 16-17 and 20-22, Applicant argues the rejection of claims 7, 12-14, 18. These arguments are moot in view of the new ground of rejections applied to claims 7, 12, 14, and 18.

In addition, with respect to the single screen in the preamble of claim 18, the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

(D) On page 20 of the Remarks, in response to applicant's argument, with respect to claim 19, that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "single screen display", "verification is done for the clinical encounter when appropriate diagnosis base clinical findings has been entered, for each clinical finding as it is entered") are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "Method For Generating Patient-Specific Flowsheets" (4878175), "System and Method For Notification And Access Of Patient Care" (5946659), "Table Modification Edit Functions" (5410704).

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim T. Bui whose telephone number is 571-272-6768. The examiner can normally be reached on Monday-Friday from 8:30A.M. to 5:00P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KTB
11/10/05.


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER